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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,866    06/29/99    LIN    W    244/031

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TM02/0212

EXAMINER

THOMPSON JR, F

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

02/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/342,866

Applicant(s)

LIN

Examiner

Forest Thompson Jr.

Group Art Unit

2165



☒ Responsive to communication(s) filed on 2/22/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-27 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2, 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Claims 1-27 have been examined.

#### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed because of the reasons set forth on the PTO-948 Form enclosed.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1, 13, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 13 are directed to a method and state desired results, but fail to provide information on the specific structure included to achieve them. Claims 1 and 13 state "based upon a performance of the buyer while participating in a price-Determinating-Activity (PDA)," in lines 7-9. Correction is required.

Claim 19 is directed to a system and states desired results, but fails to provide information on the specific structure included to achieve them. Claim 19 states "dependent on a performance of the buyer while participating in a price-Determinating-Activity (PDA)," in lines 7-9. Correction is required.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 11-16, 18-19, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by **Goldhaber et al.** (U.S. Patent 5,855,008).

As per claims 1, 13 and 19, **Goldhaber et al.** discloses:

- a computer server having access to the global communications network (col. 4 lines 18-24; col. 8 lines 26-30; col. 9 lines 32-35);
- communicating to a buyer to buy the product for a price to be determined within a price range (col. 9 lines 32-40; col. 10 lines 9-38; fig. 2 [50,52]);
- accepting a first request from the buyer to buy the product for a price to be determined within a price range (col. 10 lines 9-38; fig. 2 [50,52]);
- accepting a second request from the buyer to allow the price to be determined based on a performance of the buyer while participating in a Price-Determining-Activity (PDA) selected by the buyer (col. 10 lines 39-57; fig. 3 [56, 58, 60]);
- receiving from the buyer over the global communications network, said data representing the performance of the buyer during the selected PDA (col. 10 lines 46-57);

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- determining the price of the product based at least partially upon the data received, said price being within the price range (col. 10 line 53 - col. 11 line 31);

As per claims 2 and 15, **Goldhaber et al.** discloses the step of accepting payment information from the buyer over the global communications network (col. 38 lines 11-12).

As per claim 11, **Goldhaber et al.** discloses the price is determined at least partially upon participation of the buyer in an auction (col. 4 lines 63-64).

As per claim 12, **Goldhaber et al.** discloses the global communication network is the Internet (col. 4 lines 18-24).

As per claim 14, **Goldhaber et al.** discloses the step of receiving data over the global communications network representing an election of the buyer to select the PDA (col. 10 lines 39-57; fig. 3 [56, 58, 60]).

As per claim 16, **Goldhaber et al.** discloses:

- the price to be determined is within a price range (col. 10 line 53 - col. 11 line 31); and
- communicating the price range to the buyer over the global communications network (col. 9 lines 32-40; col. 10 lines 9-38; fig. 2).

As per claim 18, **Goldhaber et al.** discloses:

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- the price is dependent at least partially upon a bid selected by the buyer (col. 9 lines 32-40; col. 10 lines 9-67; col. 11 lines 1-31); and
- received over the global communications network (col. 4 lines 18-24; col. 9 lines 32-40; col. 10 lines 9-67; col. 11 lines 1-31).

As per claim 25, **Goldhaber et al.** discloses the price is determined at least partially upon participation of the buyer in an auction (col. 4 lines 63-64).

As per claim 26, **Goldhaber et al.** discloses the prices is determined at least partially upon an offer received from the buyer (col. 10 line 46 - col. 11 line 31).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-10, 17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goldhaber et al.** (U.S. Patent No. 5,855,008), and further in view of **Rossides** (U.S. Patent No. 5,269,521).

As per claim 3, **Goldhaber et al.** does not disclose presenting to the buyer over the global communications network, a plurality of PDAs to choose from, said presentation of the plurality of PDAs occurring before accepting the second request from the buyer. However, **Rossides** discloses presenting to the buyer over the global communications network, a plurality of PDAs to choose from, said presentation of the plurality of PDAs occurring before accepting the second request from the buyer (col. 15 line 63 - col. 16 line 11). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose presenting to the buyer over the global communications network, a plurality of PDAs to choose from, said presentation of the plurality of PDAs occurring before accepting the second request from the buyer, because this provides the user an obvious incentive to participate in the activity.

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As per claim 4, **Goldhaber et al.** does not specifically disclose presenting price determination rules to the buyer over the global communications network, said price determination rules being associated with the plurality of PDAs. However, **Rossides** discloses presenting price determination rules to the buyer over the global communications network, said price determination rules being associated with the plurality of PDAs (Abstract; col. 3 lines 36-47). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose presenting price determination rules to the buyer over the global communications network, said price determination rules being associated with the plurality of PDAs, because this encourages the buyer to buy products.

As per claim 5, neither **Goldhaber et al.** nor **Rossides** disclose the PDA is a video game. However, Official Notice is taken that it was old and well known in the art at the time the invention was made that games, including video games, are used to encourage users (in this case, buyers) to participate in selected activities to increase user participation and make selected activities more appealing to users. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine old and well known art, **Goldhaber et al.** and **Rossides** to disclose the PDA is a video game, because of the popularity of on-line video games.

As per claim 6, **Goldhaber et al.** does not specifically disclose associating the selected PDA with the product based at least partially upon a number of participants required for



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execution of the selected PDA. However, **Rossides** discloses associating the selected PDA with the product based at least partially upon a number of participants required for execution of the selected PDA (col. 24 lines 1-18). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al. and Rossides** to disclose associating the selected PDA with the product based at least partially upon a number of participants required for execution of the selected PDA, because this increases the probability that sufficient buyers will participate in the price-determining activity to achieve satisfactory results in the activity and make a sale.

As per claim 7, **Goldhaber et al.** does not specifically disclose sending the price data to the buyer via the global communications network, said price data representing the price. However, **Rossides** discloses sending the price data to the buyer via the global communications network, said price data representing the price (col. 16 lines 53-67). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al. and Rossides** to disclose sending the price data to the buyer via the global communications network, said price data representing the price, because this informs buyers of product prices which buyers will require before finalizing the sale.

As per claim 8, **Goldhaber et al.** does not specifically disclose accepting offer data from the seller representing an offer from the seller to sell the product within the price range.

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However, **Rossides** discloses accepting offer data from the seller representing an offer from the seller to sell the product within the price range (col. 42 lines 53 - col. 43 line 9). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose accepting offer data from the seller representing an offer from the seller to sell the product within the price range, because this information is desired by buyers to finalize the sale.

As per claim 9, **Goldhaber et al.** does not specifically disclose the selected PDA requires participation of at least one person in addition to the buyer. However, **Rossides** discloses the selected PDA requires participation of at least one person in addition to the buyer (col. 24 lines 1-18; col. 42 lines 39-51). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose the selected PDA requires participation of at least one person in addition to the buyer, because this informs the buyer of requirements for making a purchase at reduced selling prices.

As per claim 10, **Goldhaber et al.** discloses the steps of:

- accepting the first request from the buyer (col. 9 lines 32-40; col. 10 lines 9-38; fig. 2);
- accepting the second request from the buyer (col. 10 lines 39-57; fig. 3); and
- receiving the performance data from the buyer (col. 10 lines 46-57).

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**Goldhaber et al.** does not specifically disclose the above actions in claim 10 are performed by a master controller. However, **Rossides** disclose the above actions in claim 10 are performed by a master controller (col. 16 lines 55-63), using a host computer. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose the above actions in claim 10 are performed by a master controller, because this provides necessary functionality to the system.

As per claim 17, **Goldhaber et al.** does not specifically disclose the PDA includes participation of a second buyer, nor the step of communicating to the buyer and to a second buyer over the global communications network price determination rules. However, **Rossides** discloses:

- the PDA includes participation of a second buyer (col. 24 lines 1-18); and
- the step of communicating to the buyer and to a second buyer over the global communications network price determination rules (Abstract; col. 3 lines 36-47; col. 24 lines 1-18; col. 42 lines 39-51).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose the PDA includes participation of a second buyer, and the step of communicating to the buyer and to a second buyer over the global communications network price determination rules, because these are obvious enhancements that would increase the utility of the invention.

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As per claim 22, **Goldhaber et al.** Does not disclose the price is determined at least partially upon an offer received from the buyer, nor determining the price based at least partially upon a competition between the buyer and the at least one person using the selected PDA.

However, **Rossides** discloses:

- the price is determined at least partially upon an offer received from the buyer (ABSTRACT).
- determining the price based at least partially upon a competition between the buyer and the at least one person using the selected PDA (col. 3 lines 35-60).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Rossides** to disclose the price is determined at least partially upon an offer received from the buyer, and determining the price based at least partially upon a competition between the buyer and the at least one person using the selected PDA, because these are obvious characteristics/capabilities that provide desired functionality to the invention.

8. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goldhaber et al.** (U.S. Patent No. 5,855,008).

As per claim 20, **Goldhaber et al.** does not specifically disclose the PDA comprises computer-executable code sent to the buyer over the global communications network. Official

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Notice is taken that it was old and well known in the art at the time the invention was made that computer executable code (e.g., game software) could be downloaded, uploaded, or executed on a system remote from the user operating it. It would have been obvious to one skilled in the art at the time the invention was made to combine old and well known art with **Goldhaber et al.** and **Rossides** to disclose the PDA comprises computer-executable code sent to the buyer over the global communications network, since this is one way that the user may be provided access to the PDA software in order to participate in the PDA activity.

As per claim 21, **Goldhaber et al.** discloses the step of accepting payment information from the buyer over the global communications network (col. 38 lines 11-12).

9. Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goldhaber et al.** (U.S. Patent No. 5,855,008), and further in view of **Kelly et al.** (U.S. Patent No. 5,816,918).

As per claim 24, **Goldhaber et al.** does not specifically disclose the at least one person is a second buyer; accepting a second request from the second buy to buy the product for a second price to be determined within the price range; nor determining said second price based at least partially upon the competition. However, **Kelly et al.** discloses:

- the at least one person is a second buyer (col. 3 lines 30-46);

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- accepting a second request from the second buy to buy the product for a second price to be determined within the price range (col. 3 lines 30-46); and
- determining said second price based at least partially upon the competition (col. 3 lines 30-46).

It would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Kelly et al.** to disclose the at least one person is a second buyer, accepting a second request from the second buy to buy the product for a second price to be determined within the price range, and determining said second price based at least partially upon the competition, because this increases the functionality of the invention.

As per claim 27, **Kelly et al.** discloses determining the price based at least partially upon a competition between the buyer and the second buyer using the selected PDA (col. 3 lines 30-46).

As per claim 27, **Goldhaber et al.** does not specifically disclose determining the price based at least partially upon a competition between the buyer and the second buyer using the selected PDA. However, **Kelly et al.** discloses determining the price based at least partially upon a competition between the buyer and the second buyer using the selected PDA (col. 3 lines 30-46). It would have been obvious to one skilled in the art at the time the invention was made to combine **Goldhaber et al.** and **Kelly et al.** to disclose determining the price based at least partially upon a competition between the buyer and the second buyer using the selected PDA, because this increases the functionality and desirability to customers of the invention.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes:

- **Walker et al.** (U.S. Patent No. 5,794,207) discloses a method and apparatus for effectuating bilateral buyer-driven commerce;
- **Sheldon** (WO 00/24484) discloses a method of playing a game and for providing information services together with advertising interactively on a communications network;
- **Zuiff et al.** (WO 00/05668) discloses a method and apparatus for obtaining consumer data in exchange for consumer incentives at a point-of-sale;
- Kuntz, Mary; "Point, click--and here's the price: Yoyodyne uses prizes to get you to read those online ads;" Business Week, pg. ENT8, number 3564, 09 February 1998.
- "Alottafun! To develop extensive Internet site;" PR Newswire; 03 December 1998.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

February 8, 2001 /FOT

A handwritten signature in black ink, appearing to be 'FOT' or similar, written above the date.A handwritten signature in black ink, appearing to be 'Vincent Millin', written above the printed name.

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100